

See Paper
No. 9

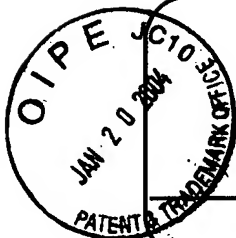
2134

PTO/SB/21 (08-03) (AW 10/2003)

Approved for use through 7/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission **13**

Application Number	10/066,901
Filing Date	February 4, 2002
First Named Inventor	Yoshiho Gotoh, et al
Art Unit	2134
Examiner Name	Paul E. Callahan
Attorney Docket No.	MTS-710US26

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ENCLOSURES (Check all that apply)

- ☐ Fee Transmittal Form
 - ☐ Fee Attached
- ☐ Amendment/Reply
 - ☐ After Final
 - ☐ Affidavits/Declaration(s)

- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/
Incomplete Application
 - ☐ Response to Missing Parts under
37 CFR 1.52 or 1.53

- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☒ Petition
- ☐ Petition to Convert to a
Provisional Application
- ☐ Power of Attorney, Revocation,
Change of Correspondence
Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____

- ☐ After Allowance Communication
to Group
- ☐ Appeal Communication to Board
of Appeals and Interferences
- ☐ Appeal Communication to Group
(Appeal Notice, Brief, Reply
Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please
identify below):
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Remarks:

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm or Individual	Lawrence E. Ashery	Registration No. (Attorney/Agent)	34,515
Signature			
Date	January 15, 2004		

CERTIFICATE OF TRANSMISSION / MAILING

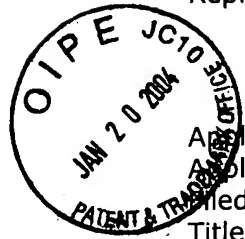
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date:

January 15, 2004

Name (Print/Type)	Lawrence E. Ashery
Signature	
Date	January 15, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, ALEXANDRIA, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.: 10/066,901
Applicant: Y. Gotoh et al.
Filed: February 4, 2002
Title: OPTICAL DISK, AN OPTICAL DISK BARCODE FORMING METHOD, AN OPTICAL DISK REPRODUCTION APPARATUS, A MARKING FORMING APPARATUS, A METHOD OF FORMING A LASER MARKING ON AN OPTICAL DISK, AND A METHOD OF MANUFACTURING AN OPTICAL DISK
TC/A.U.: 2134
Examiner: Paul E. Callahan
Confirmation No.: 5932
Docket No.: MTS-710US26

PETITION UNDER 37 CFR 1.181 TO RESCIND ABANDONMENT

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

A Notice of Abandonment dated January 12, 2004 (copy enclosed) was issued in error by the United States Patent and Trademark Office. This Petition is being filed to rescind the abandonment, return this application to pending status, and resume prosecution. The relevant facts are as follows:

(1) On September 22, 2003 an Amendment (copy enclosed) was filed with the United States Patent and Trademark Office in response to the June 20, 2003 Office Action as evidenced by the enclosed copy of the postcard date-stamped by the United States Patent and Trademark Office.

(2) On December 18, 2004, Applicants' Attorney's office called Examiner Paul Callahan to inquire as to the status of the September 22, 2003 Amendment. Examiner Callahan agreed to check into the status of the Amendment and report his findings to Applicants' Attorney's office.

(3) On December 19, 2004, Examiner Callahan called Applicants' Attorney's office and stated that he could find no record of the September 22, 2003 Amendment being entered

Reply to Office Communication Dated: January 12, 2004

into the Patent Application Information Retrieval system of the United States Patent and Trademark Office.

(4) On January 8, 2004, Applicants' Attorney's office faxed a copy of the Amendment and accompanying papers filed on September 22, 2003 to the United States Patent and Trademark Office Centralized Fax location, as required by the December 1, 2003 Centralized Delivery and Facsimile Transmission Requirements For Patent Application Related Correspondence, indicating on the facsimile cover sheet "Amendment As Previously Filed." A copy of the facsimile confirmation cover sheet showing successful transmission of the facsimile is enclosed.

For the reasons set forth above, it is respectfully requested that the Notice of Abandonment be withdrawn and the Amendment filed on September 22, 2003 be entered.

Respectfully submitted,

RatnerPrestia

Lawrence E. Ashery, Reg. No. 34,515
Attorney for Applicants

LEA/ds

Enclosures: Notice of Abandonment
Amendment dated September 22, 2003
Date Stamped Postcard
Copy of January 8, 2004 Facsimile Confirmation Cover Sheet

Dated: January 15, 2004

P.O. Box 980
Valley Forge, PA 19482

The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. **18-0350** of any fees associated with this communication.

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2 msc

MTS-710US26



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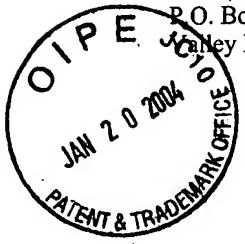
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,901	02/04/2002	Yoshiho Gotoh	MTS-710US26	5932

7590 01/12/2004

Ratner & Prestia
500 North Gulph Road
P.O. Box 980
Valley Forge, PA 19482



JAN 14 2004

EXAMINER

CALLAHAN, PAUL E

ART UNIT PAPER NUMBER

2137

DATE MAILED: 01/12/2004

8

Petition to revive (imp)
2/12/04/led

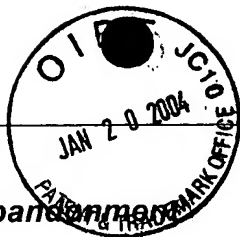
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2



Notice of Abandonment

Application No.

10/066,901

Examiner

Paul E. Callahan

Applicant(s)

GOTOH ET AL.

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 20 June 2003.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

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Paul Callahan
Paul Callahan
1/8/04

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

MEMORY TRANSMISSION REPORT

PAGE : 001
TIME : 01-08-2004 03:34PM
TEL NUMBER: 610 407 0701
NAME : RatnerPrestia

FILE NUMBER : 982
DATE : 01-08 03:28PM
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START TIME : 01-08 03:28PM
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FACSIMILE COVER SHEET

DATE: January 8, 2004
TIME:

OUR REF.: MTS-710 US26
YOUR REF.: 10/066,901

TO:	CENTRALIZED FAX
COMPANY:	United States Patent and Trademark Office
FROM:	Lawrence E. Ashery
FAX TELEPHONE:	(703) 872-9306
OFFICE TELEPHONE:	
TITLE OF DOCUMENT:	Amendment

Total Number of Pages: 7 (Including this form)

COMMENTS

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FACSIMILE COVER SHEET

DATE: January 8, 2004

OUR REF.: MTS-710 US26

TIME: _____

YOUR REF.: 10/066,901

TO: CENTRALIZED FAX

COMPANY: United States Patent and Trademark Office

FROM: Lawrence E. Ashery

FAX TELEPHONE: (703) 872-9306

OFFICE TELEPHONE: _____

TITLE OF DOCUMENT: Amendment

Total Number of Pages: 7 (including this form)

COMMENTS

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FILE NO.: 710 US 26 MTS 710 US 26 FEE DUE? YES or NO AMT. ENCD. \$

NAME: V. Gatch et al.

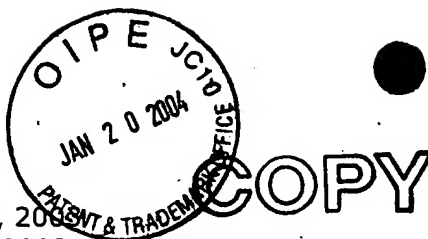
- | | |
|---|--|
| <input type="checkbox"/> Specification (_____ pp.) | <input type="checkbox"/> Drawing(s) (_____ pp.) |
| <input type="checkbox"/> IDS & PTO 1449 (_____ pp.) | <input type="checkbox"/> Copy of _____ Reference(s) |
| <input type="checkbox"/> Copy of Search Report | <input type="checkbox"/> Form 1390 + copy |
| <input type="checkbox"/> Claim to Right of Priority | <input type="checkbox"/> Priority Document(s) |
| <input type="checkbox"/> Response to Missing Parts | <input type="checkbox"/> Copy of Formalities Letter |
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| <input type="checkbox"/> Petition for Ext. of Time | <input type="checkbox"/> Assignment & Form 1595 |
| <input type="checkbox"/> Utility Transmittal | <input type="checkbox"/> Fee Transmittal + copy |
| <input type="checkbox"/> Amendment/Response (<u>4</u> pp.) | <input type="checkbox"/> Preliminary Amendment (_____ pp.) |
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Serial No.: 19/266,941



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Appln. No.: 10/066,901
Amendment Dated September 22, 2003
Reply to Office Action of June 20, 2003



MTS-710US26

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No: 10/066,901
Applicant: Y. Gotoh et al.
Filed: February 4, 2002
Title: OPTICAL DISK, AN OPTICAL DISK BARCODE FORMING METHOD, AN
OPTICAL DISK REPRODUCTION APPARATUS, A MARKING FORMING
APPARATUS, A METHOD OF FORMING A LASER MARKING ON AN OPTICAL
DISK, AND A METHOD OF MANUFACTURING AN OPTICAL DISK
TC/A.U.: 2134
Examiner: Paul E. Callahan
Confirmation No.: 5932
Docket No.: MTS-710US26

AMENDMENT

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Alexandria, VA 22313-1450

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Sir:

Responsive to the Office Action dated June 20, 2003, please amend the above-identified application as follows:

- ☐ **Amendments to the Specification** begin on page of this paper.
- ☒ **Amendments to the Claims** are reflected in the listing of claims which begins on page **2** of this paper.
- ☐ **Amendments to the Drawings** begin on page of this paper and include an attached replacement sheet(s).
- ☐ **Amendments to the Abstract** are on page of this paper. A clean version of the Abstract is on page of this paper.
- ☒ **Remarks/Arguments** begin on page **3** of this paper.

Amendments to the Claims: This listing of claims will replace all prior versions, and listings, of claims in the application

Listing of Claims:

Claims 1-35 (canceled)

36. (Currently Amended) An optical disk, comprising:

an information recording area;

a barcode-like mark;

an identifier for indicating whether or not said barcode-like mark is present on said optical disk, ~~and~~

said barcode-like mark including a plurality of bars, each of said bars extending in a radial direction, and

wherein said identifier is provided in the information recording area.

37. (Previously Presented) An optical disk according to claim 36, wherein

an identifier which indicates whether the barcode-like marks are present or not, is provided in the control data area of information recording area.

38. (New) An optical disk, comprising:

a barcode-like mark;

an identifier on said optical disk and separate from said barcode-like mark for indicating whether or not said barcode-like mark is present on said optical disk, and

said barcode-like mark including a plurality of bars, each of said bars extending in a radial direction.

Remarks/Arguments:

Claims 36 and 37 have been rejected under obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,052,465. Furthermore, claims 36 and 37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,706,047 (Lentz et al.) in view of U.S. Patent No. 3,752,961 (Torrey) and Official Notice. It is respectfully submitted, however, that these claims are patentable over the art of records for the reasons set forth below.

Applicants' invention, as recited by claim 36, includes a feature which is neither disclosed nor suggested by the art of record, namely:

. . .an information recording area. . .

an identifier for indicating whether or not said barcode-like mark is present on said optical disk. . .

said identifier is provided in the information recording area

This feature is supported by the originally filed application at page 3, lines 1 -5. No new matter has been added.

This feature is not recited in claims 1 and 2 of U.S. Patent No. 6,052,465. Therefore, withdrawal of the obviousness-type double patenting rejection is respectfully requested.

In addition, neither Lentz nor Torrey disclose this feature. The Official Action acknowledges that "Lentz does not teach inclusion of an identifier." Furthermore, the Official Action acknowledges that "Torrey does not teach the use of an identifier." Thus, even by combining Lentz and Torrey, Applicants' claim 36 does not result. While the Official Action takes official notice "that the use of a control data area of a disk to write identifiers is a step that is old and well known in the art," no reference has been placed on the record which discloses the feature of an identifier which indicates presence or absence of a barcode. As this feature is neither disclosed nor suggested by the art of record, claim 36 is patentable over the art of record.

Claim 37 is also patentable by virtue of its dependency on allowable claim 36.

Appln. No.: 10/066,901
Amendment Dated September 22, 2003
Reply to Office Action of June 20, 2003

MTS-710US26

Applicants have added new claim 38. Claim 38 recites the feature of:

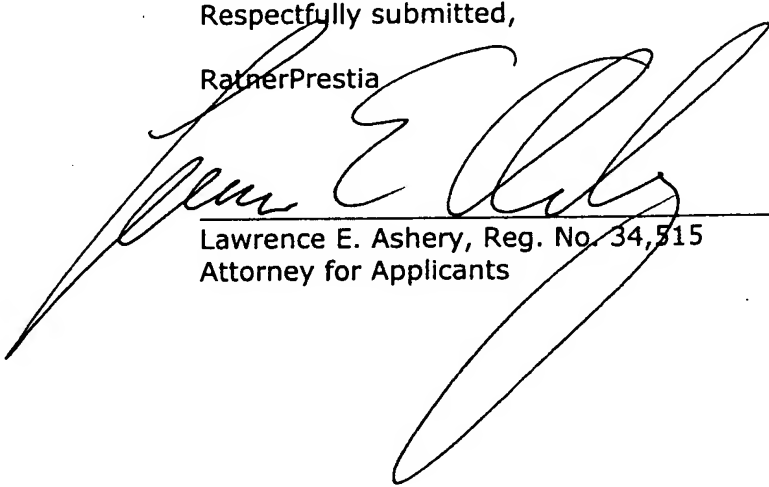
...an identifier on said optical disk and separate from said barcode-like mark for indicating whether or not said barcode-like mark is present on said optical disk

Again, this feature is neither disclosed nor suggested by the art of record. Accordingly, claim 38 is patentable over the art of record.

For the reasons set forth above, the above-identified application is in condition for allowance which action is respectfully requested.

Respectfully submitted,

RatnerPrestia


Lawrence E. Ashery, Reg. No. 34,515
Attorney for Applicants

LEA/kc

Dated: September 22, 2003

P.O. Box 980
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(610) 407-0700

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September 22, 2003

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